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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT SESEK, CLAY HIGGINS and DONALD OUCHIDA

Appeal 2009-0458
Application 10/022,142
Technology Center 3600

Decided: ¹March 25, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Robert Sesek, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-34. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM but add a new ground of rejection under 35 U.S.C. §101.²

THE INVENTION

The invention is a method of notifying a carrier in a mass mailing operation of an anticipated mail load to allow the carrier to adapt to the mail load instead of merely reacting to it. (Specification 4:10-12.) The method includes the steps of monitoring mail production and producing a forecast of the mail load. (Specification 4: 12-14.) The forecast is then told to the carrier. *Id.* The carrier is also notified if there is a change in the forecast based on the monitoring. (Specification 4:14-16.)

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Sep. 13, 2007) and Reply Brief ("Reply Br.," filed Feb. 12, 2008), and the Examiner's Answer ("Answer," mailed Dec. 12, 2007).

1. A method of feed forward mail load notification to a carrier in a mass mailing operation, comprising the steps of:
 - monitoring an actual mail production characteristic;
 - transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the actual mail production characteristic; and
 - notifying the carrier of a change in said mail load forecast if said monitoring step indicates a variance in the mail production characteristic that can affect the accuracy of the transmitted mail load forecast.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Sansone	US 5,072,401	Dec. 10, 1991
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The following rejections are before us for review:

1. Claims 1-8, 11-14, 16, 18-25, 28-31, and 33 are rejected under 35 U.S.C. §102(b) as being anticipated by Sansone.
2. Claims 9, 10, 15, 17, 26, 27, 32, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sansone.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-8, 11-14, 16, 18-25, 28-31, and 33 under 35 U.S.C. §102(b) as being anticipated by Sansone. The issue turns

on whether Sansone describes a mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the actual mail production characteristic. The rejection of claims 9, 10, 15, 17, 26, 27, 32, and 34 also turns on this issue.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites a method including the steps of “monitoring an actual mail production characteristic” and “transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the actual mail production characteristic.”
2. Claim 18 recites an apparatus comprising “means for monitoring an actual mail production characteristic” and “means for transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the mail production characteristic.”
3. The Appellants state that the means for transmitting is controller 36 in the Specification. (App. Br. 3.)
4. The Specification does not provide a definition for “forecast”.
5. The ordinary and customary meaning of “forecast” is “to calculate or predict (some future event or condition) usu. as a result of study

and analysis of available pertinent data.” (*See Merriam-Webster’s Collegiate Dictionary* 456 (10th Ed. 1998.)(Entry for “forecast.”)

6. The Specification does not provide a definition for “predict”.
7. The ordinary and customary meaning of “predict” is “to declare or indicate in advance.” (*See Merriam-Webster’s Collegiate Dictionary* 918 (10th Ed. 1998.)(Entry for predict.)

Sansone

8. Sansone relates to a system that optimizes delivery of bulk mail from mailers to a post office. (Col. 3, ll. 26-28.)
9. Sansone system includes mailer/users 110, 112 who deliver batches of mail to a second station 121 and information about the batches of mail to a central data center 118. (Col. 9, ll. 39-47.)
10. In Column 10, lines 22-25, Sansone states, ‘[b]y “batch parameters” is meant the various items recited in U.S. Pat. No. 5,005,124 such as weight, size, mail class, destination, address modes, font, zip codes, bar codes, etc.’
11. Sansone describes the central data center 118 coordinating the delivery of the batches of mail to and from the second station and the activities in the second station. (*See* Col. 11, l. 6 – Col. 12, l. 15.)
12. Sansone describes the second station densifying the received mail from the mailer/user into new mail batches for delivery to the U.S. Postal Service. (Col. 11, ll. 54-59.)
13. In Col. 12, ll. 24-29, Sansone states:

Before actually dropping off the physical mail at the various depots selected, they each can be

informed by a communications link directly (see numerals 133, 134) or via the data center 118 and United States Postal Service main station 120 (see communications paths 136, 137, 138, 139 and 140) of the new mail data or batch parameters and the estimated time of arrival (ETA) at the various depots.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

The Rejection Under 35 U.S.C. § 102(b)

The Method Claims 1-8, 11-14, and 16

The Appellants argue that Sansone does not describe the step of transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the actual mail production characteristic. (App. Br. 4.) The Appellants argue that Sansone transmits *actual* mail load information to the post office and not a *forecast* corresponding to a *predicted* number of mail pieces as in claim 1. *Id.* The Appellants argue that the information is not a forecast since the mail load actually exists at the time the information is transmitted even though the mail load has not yet been delivered. (Answer 5.)

The Examiner contends that Sansone transmits a forecast because “until the mail is printed and delivered, then they are not actual numbers, and therefore the examiner considers them to be forecasts.” (Answer 7.) The Examiner has construed the word “forecast” to mean “prediction of future happening” or “an indication of something that is likely to occur.” (Answer 7.)

“Analysis begins with a key legal question -- *what* is the invention *claimed*? Courts are required to view the claimed invention *as a whole*. 35 U.S.C. § 103. Claim interpretation, in light of the specification, claim language, other claims, and prosecution history, is a matter of law and will

normally control the remainder of the decisional process.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1987).

Claim 1 states, “transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the actual mail production characteristic.” (FF 1.) The Specification does not include an express definition of “forecast” or “predict.” (FF 4 and 6.) We find that the ordinary and customary meaning of “forecast” is to calculate or predict (FF 5), and the ordinary and customary meaning of “predict” is to declare or indicate in advance. (FF 7.) Therefore, given the broadest reasonable construction of the claim in light of the Specification as it would be interpreted by one of ordinary skill in the art, we construe the claimed transmitting step to require transmitting a calculated or predicted mail load to the carrier. The predicted mail load corresponding to a number of mail pieces that is indicated in advance. The number of mail pieces, which are indicated in advance, is determined at least in part by the actual mail production characteristic. We note that the claim does not recite a timeframe for the forecast or prediction of the number of mail pieces. The timeframe could be in advance of batching, as argued by the Appellants, or in advance of delivery, as argued by the Examiner. We construe the claim 1 to encompass both.

We find that Sansone does describe the step of transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the actual mail production characteristic. In column 12, lines 24-28, Sansone states:

Before actually dropping off the physical mail at the various depots selected, they each can be

informed by a communications link directly (see numerals 133, 134) or via the data center 118 and United States Postal Service main station 120 (see communications paths 136, 137, 138, 139 and 140) of the new mail data or batch parameters and the estimated time of arrival (ETA) at the various depots.

We find this statement to be a forecast of when a certain mail load will arrive at the post office depots. It is a prediction or calculation of when a predicted number of mail pieces will be delivered. The predicted number of mail pieces being the number of mail pieces to be delivered.

Therefore, we hold that the Appellants have not shown that the Examiner erred in rejecting claims 1-8, 11-14, and 16 and, accordingly, the rejection of these claims is affirmed.

The Apparatus Claims 18-25, 28-31, and 33

The Appellants argued against the rejection of independent claim 18 and dependent claims 19-25, 28-31 and 33 for the same reasons used to argue against the rejection of claim 1. (App. Br. 5.) We note that claim 18 recites an apparatus instead of a method. The apparatus includes a “means for transmitting a mail load forecast to the carrier, the mail load forecast corresponding to a predicted number of mail pieces determined at least in part by the mail production characteristic.” (FF 2.) Appellants state that this limitation corresponds to controller 36, which performs the recited function, in the Specification. (App. Br. 3.)

As discussed above with regards to claim 1, we find that controller 118 of Sansone performs the claimed transmitting step. We find that controller 118 is an equivalent of controller 36. Therefore, we find that the

Appellants have not shown that the Examiner erred in rejecting claim 18. Accordingly, the rejection of claim 18 and its dependent claims 19-25, 28-31, and 33 is affirmed.

The Rejection of Claims 9, 10, 15, 17, 26, 27, 32, and 34 under 35 U.S.C. § 103(a)

The Appellants argued against the rejection of claims 9, 10, 15, 17, 26, 27, 32, and 34 for the same reasons used to argue against the rejection of claims 1 and 18. (App. Br. 5). Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claims 9, 10, 15, 17, 26, 27, 32, and 34. The rejection of claims 9, 10, 15, 17, 26, 27, 32, and 34 is affirmed.

NEW GROUND

Pursuant to 37 CFR § 41.50(b), we enter a new ground of rejection. We reject claims 1-17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. We take claim 1 as representative.

The issue is whether the process as claimed is patent eligible under 35 U.S.C. §101.

Claim 1 describes a method of feed forward mail load notification to a carrier comprising the steps of 1) monitoring an actual mail production characteristic, 2) transmitting a mail load forecast to the carrier and 3) notifying the carrier of a change in said mail load forecast. The method claimed recites steps and is thus nominally drawn to a process. However, "the proper inquiry under §101 is not whether the process claim recites sufficient "physical steps," but rather whether the claim meets the machine-

or-transformation test. As a result, even a claim that recites "physical steps" but neither recites a particular machine or apparatus, nor transforms any article into a different state or thing, is not drawn to patent-eligible subject matter. Conversely, a claim that purportedly lacks any "physical steps" but is still tied to a machine or achieves an eligible transformation passes muster under § 101." *In re Bilski*, 545 F.3d 943, 961 (Fed. Cir. 2008) (en banc).

Here, the claimed method is not tied to a machine nor does it transform a particular article into a different state or thing. Claim 1 does not recite a machine or apparatus. The method of claim 1 also does not transform a particular article into a different state or thing. Claim 1 does not transform the mail or any other particular article. Claim 1 does transmit a forecast and, if needed, an updated forecast. However, a forecast is not a particular article since it is not physical object or substance nor does the forecast represent a physical object or substance. *See Id.* at 963.

Therefore, we reject claims 1-17 under 35 U.S.C. § 101 as being drawn to nonpatentable subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1-8, 11-14, 16, 18-25, 28-31, and 33 under 35 U.S.C. §102(b) as being anticipated by Sansone and claims 9, 10, 15, 17, 26, 27, 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Sansone. We enter a new grounds of rejection of claims 1-17 under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1-34 is affirmed and we enter a new ground of rejection of claims 1-17 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

Appeal 2009-0458
Application 10/022,142

AFFIRMED; 37 C.F.R. § 41.50(b)

LV:

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